

REMARKS

Claims 1 and 3-5 are pending in the application. Claims 6-51 have been canceled pursuant to their having been withdrawn owing to a restriction requirement. The cancellation of claims 6-51 is without prejudice to applicant's right to submit those claims in a subsequent divisional application.

Claims Rejections - 35 U.S.C. § 103

Claims 1 and 3-5 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,536,267 to Edwards et al. ("Edwards") in view of U.S. Patent No. 5,354,279 to Höfling.

As discussed in a prior Amendment, applicant's invention is particularly designed for use in an endoscopic procedure to raise polyps from a colon wall so that the polyps may be removed without perforating the colon. The present invention renders polypectomies safer.

Edwards discloses an electrocautery ablation device wherein a plurality of electrodes in the form of hollow needles (20a) are connected to a tubular support and introducer member (12). The electrodes extend all the way back from the distal end of the instrument to the proximal end through the tubular support or introducer member (Figures 2 and 7). The electrodes therefore do not and cannot communicate with the lumen of the tubular support and introducer member (12).

It would not be obvious to modify the Edwards device to have multiple needles communicating with a single lumen. The needles of the Edwards device are *electrodes*. There must be conduction of not only fluid through the electrodes but also electrical current. With the needles extending all the way back to proximal end of the instrument,

as shown in Edwards, the electrical connections are clear and well within the level of skill in the art. If the needles were all to communicate with a single lumen, as proposed by the Examiner, it is not at all clear how the electrical current would be carried. Without a proper electrical signal path, the Edwards device would not work for its intended purpose – tissue ablation. There is nothing in the Höfling reference that would help one of ordinary skill in the art in reconfiguring the electrical circuit paths of the Edwards device to accommodate the modification in fluid flow paths proposed by the Examiner.

The Examiner maintains that it would be obvious to modify the electrocautery ablation device of Edwards to have the hollow needles communicate with the lumen of the tubular support or introducer member. The Examiner cites the following excerpt from Höfling (col. 5, lines 17-20):

If several needles are required because of the greater stability and the possibility to introduce a greater amount of medicine, the inner hose 20 is preferably a multi-lumen hose.

The Examiner contends that this excerpt implies that multiple needles can be connected to a single lumen.

Applicant respectfully traverses the Examiner's reading of the Hofling excerpt and maintains that the reading is skewed by the hindsight provided by applicant's claimed invention. Rather than reading the excerpt in the light of applicant's claims, the excerpt should be read in the light of Höfling's own disclosure, particularly the immediately preceding passage (col. 5, lines 8-16):

In order to provide good support at least three needles should be utilized. However any number of needles may be used and they can be evenly or unevenly distributed over the cross-section of the head. With a larger number of needles also the

amount of medicine admitted through the needles can be increased. With very narrow vessels or veins however there may not be sufficient space for a large catheter. Then also only a single needle may be used.

In the excerpt relied on by the Examiner, Höfling is contrasting a single needle with multiple needles, not multiple needles with more needles. Multiple needles provide greater stability than one needle. Three needles provide "good support." Two needles would provide more support than one needle and four needles would provide more support than three needles. In addition, the greater the number of needles the more medicine that could be delivered to the target tissues. Multiple needles are connected to multiple lumens, a single needle is connected to a single lumen.

Conclusion

For the foregoing reasons, independent claim 1, as well as claims 3-5 dependent therefrom, is deemed to be in condition for allowance. An early Notice to that effect is earnestly solicited.

A Notice of Appeal is submitted herewith.

Should the Examiner believe that direct contact with applicant's attorney would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the number below.

Respectfully submitted,
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